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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/601,484	08/03/2000	GERD MAROWSKY	2000_0964A	5835

7590 07/28/2003

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EXAMINER

FULLER, RODNEY EVAN

ART UNIT

PAPER NUMBER

2851

DATE MAILED: 07/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/601,484	MAROWSKY ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Rodney E Fuller	2851

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 14 May 2003.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

4) Claim(s) 1-10 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-10 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 03 August 2000 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Remarks***

In response to applicant's Amendment, dated May 14, 2003, the examiner acknowledges the substitute Specification, which addresses the objection to the Specification as set forth in the Office Action mailed February 14, 2003.

Regarding the 35 U.S.C. 102(b) rejection of claims 1-3 and 7-10 as being anticipated by Herron, et al. (US 5,677,196), the applicant makes the argument that (claims 1 and 4) "Herron fails to disclose or suggest generating luminescence by non-evanescent excitation in a volume of an analyte sample." The examiner notes that Herron discloses the use of a "non-evanescent" light source in column 30, line 52. Thus, the examiner has considered the applicant's arguments in light of the amended claims and maintains the rejection.

Regarding the 35 U.S.C. 103(a) rejection of claims 4-6 as being unpatentable over Herron, et al. (US 5,677,196) in view of Kraus, et al. (US 6,198,869), the applicant makes the argument that "generating luminescence by non-evanescent excitation in a volume of an analyte sample as luminescence radiation" "is not disclosed or suggested in Herron or Kraus." As above, the examiner notes that Herron discloses the use of a "non-evanescent" light source in column 30, line 52. Thus, the examiner has considered the applicant's arguments in light of the amended claims and maintains the rejection.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3 and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Herron, et al. (US 5,677,196).

Herron discloses all the structure set forth in the claims. Regarding claims 1-3 and 7-10, Herron discloses a device for measuring luminescence generated in an analyte sample by excitation radiation (and the associated method of using said device) that comprises “a) an optical layer waveguide (Fig. 1, ref.# 122, column 3, line 49) with a transparent substrate and a waveguiding layer; b) an analyte sample (column 1, line 27; abstract, lines 8-13) which is located in contact with the waveguiding layer; c) an electric or optical energy source (Fig. 1, ref.# 100; column 30, lines 41-58) which is arranged such that the electrodes of the electric energy source are located in direct contact with the analyte sample, or the excitation radiation of the optical energy source is directed directly onto the analyte sample at an inclined or right angle, or a reservoir containing a chemical which excites a chemiluminescence in contact with the analyte sample; and d) an optoelectronic detection unit (Fig. 1, ref.# 150; column 6, lines 32-34) for measuring the luminescence radiation generated by the action of electric field or excitation radiation.”

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herron, et al. (US 5,677,196) in view of Kraus, et al. (US 6,198,869).

Herron discloses all the structure set forth in the claims except for explicitly teaching the use of "diffractive" output couplings with the waveguide. However, the use of diffractive elements with a waveguide is routine in the art as is evident from the teaching of Kraus (See Abstract). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Herron by including diffractive output couplings with the waveguide. The ordinary artisan would have been motivated to modify Herron in the manner described above in order to efficiently couple the light out of the waveguide at particular areas of the waveguide.

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney Fuller whose telephone number is (703) 306-5641. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russ Adams, can be reached on (703) 308-2847.

Rodney Fuller  
Primary Examiner

July 22, 2003

